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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,159	02/15/2000	Lalitha Vaidyanathan	11374-002001	7527

28863 7590 09/07/2004
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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/504,159	Applicant(s) VAIDYANATHAN ET AL.	
	Examiner Jan Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 20-22, 25-31, 64-73, 93-100 and 108-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 20-22, 25-31, 64-73, 93-100 and 108-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on April 12, 2004, wherein:

Claims 1-17, 20-22, 25-31, 64-73, 93-100, and 108-117 are currently pending;

Claims 1-3, 20 22, 25, 26, 28-31, 64 and 93 are currently amended;

Claims 18-19, 23-24, 32-63, and 74 are canceled and Claims 75-92 and 101-107 have been withdrawn;

Claims 109-117 have been added.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2004 has been entered.

Response to Amendment

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-10, 12-13, 15-17, 20-22, 25-27, 64-73, 93-99, 100,109, 111-112, and 115-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloo (US 5,895, 450) (hereinafter referred to as Sloo).

Referring to Claims 1 and 112:

Sloo discloses a method and a system for resolving an electronic commerce dispute involving one or more parties, comprising:

electronically providing access to an online dispute resolution system to allow at least one of the parties to initiate a filing of the dispute from an online marketplace (Figs. 1-6, col. 2, line 53 thru col. 3, line 7);

electronically receiving with the online dispute resolution system transaction data from the marketplace, wherein the transaction data describes transactions within the marketplace (Figs. 3-9; col. 2, lines 7-20)

receiving from at least one of the parties information related to the dispute (col. 2, lines 53-65; col. 3, lines 19-29) and

executing software with the online dispute resolution system (artificial intelligence (e.g. neural network linking)) to apply an online dispute resolution process that utilizes at least a portion of the transaction data from the market place and the information to assist the parties in resolving the dispute (col. 14, lines 2-16, lines 33-36, col. 3, lines 8-67).

Referring to Claim 2 and 64:

Sloo discloses a method and system further comprising automatically selecting one of two modes of resolving the dispute, the first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties in resolving the dispute and the second

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mode involving a human dispute resolution specialist (col. 13, line 50 thru col. 14, line 16, col. 14, lines 8-11, Figs. 1-9, col. 3, lines 8-67).

Sloo discloses plurality of methods to settle a dispute (Fig. 7). Sloo's methods for resolving disputes includes a first mode requiring the online dispute resolution process being driven by an electronic agent to assist the parties (negotiation) and the second mode involving a human dispute resolution specialist (judge/jury).

Referring to Claim 3:

Sloo discloses a method wherein the case-based reasoning system contains a history file (Fig. 2 (206-216), col. 9, lines 32-48, col. 14, lines 33-36).

Referring to Claim 4:

Sloo discloses a method and system wherein the history file contains patterns and precedents, further comprising applying the patterns and precedents to generate an outcome prediction (col. 10, line 54 thru col. 11, line 2).

Referring to Claim 5:

Sloo discloses a method further comprising presenting the outcome prediction to the parties to assist the parties in selecting the mode of resolving the dispute (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 14, lines 33-44, Fig. 2).

Referring to Claim 6:

Sloo discloses a method wherein the outcome prediction includes one or more likely outcomes and associated probabilities of occurrence (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 7:

Sloo discloses a method further comprising receiving settlement position from the parties (col. 2, lines 53-65, col. 4, lines 63-65, col. 7, line 66 thru col. 8, line 4).

Referring to Claim 8:

Sloo discloses a method system further comprising automatically settling the dispute if the settlement positions satisfy a predetermined criteria (Automatic Negotiator – col. 10, lines 35-39).

Referring to Claim 9:

Sloo discloses a method wherein the predetermined criteria relates to a monetary settlement position (col. 7, line 66 thru col. 8, line 4).

Referring to Claim 10:

Sloo discloses a method wherein the predetermined criteria relates to non-monetary settlement position (col. 7, line 66 thru col. 8, line 4).

Referring to Claim 12:

Sloo discloses a method wherein the dispute resolution specialist generates a final recommended resolution (Fig. 7 (720)).

Referring to Claim 13:

Sloo discloses a method wherein the final recommended resolution is accepted by the one or more parties (col. 9, lines 50-52, col. 11, lines 37-42).

Referring to Claim 15:

Sloo discloses a method further comprising communication among the parties using a plurality of communication modes (Fig. 2, communication network, col. 6, lines 55-67).

Referring to Claim 16:

Sloo discloses a method wherein the communication modes include a public messaging mode in which communication is automatically shared between all of the parties and the dispute resolution specialist, and a private messaging mode in which communication for a given one of the parties is automatically shared only between that one of the parties and the dispute resolution specialist (Figs. 2, 7, col. 2, lines 7-9, col. 3, lines 30-38).

Referring to 17:

Sloo discloses a method wherein the communication mode is selected by the dispute resolution specialist (col. 6, lines 55-64). It is inherent that the mode of communication can be selected by the system or the users which would include the dispute resolution specialist.

Referring to Claims 20-21:

Sloo discloses a method further comprising providing visual cues when applying the dispute resolution process to automatically highlight agreements between the parties (col. 13, lines 12-17).

Referring to Claim 22:

Sloo discloses a method further comprising storing status data on participation of the parties in the dispute resolution process (col. 2, lines 7-20, col. 10, lines 54-64).

Referring to Claim 25:

Sloo discloses a method wherein the data relates to compliance of a participant to a result of the resolution of the dispute (col. 2, lines 7-20, col. 10, lines 53-64).

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Referring to Claim 26:

Sloo discloses a method further comprising communicating the status data from the dispute resolution system to the marketplace and highlighting an offender based on the status information (col. 8, lines 50-65, col. 12, line 47 thru col. 13, line 24, cols. 17-18 –Example).

Referring to Claim 27:

Sloo discloses a method further comprising providing a market-based system for assigning the dispute resolution specialist to a particular dispute (col. 8, lines 5-19).

Referring to Claim 72:

Sloo discloses a method further comprising determining a current mode of resolving the dispute; and automatically selecting a communication mode based on the determination (col. 10, line 54 thru col. 11, line 36, col. 6, lines 55-68).

Referring to Claim 73:

Sloo discloses a method further comprising providing the data to the parties to assist the resolution dispute (col. 10, line 54 thru col. 11, line 5)

Referring to Claim 100:

Sloo discloses a method further comprising maintaining a database that stores facts and outcome of previously resolved electronic commerce disputes, and wherein executing software apply a case-based reasoning system comprises:

searching the database to identify previously resolved disputes with facts that are similar to the case information (col. 4, lines 14-17, col. 10, line 54 thru col. 11, line 2);

identifying at least one likely outcome of the dispute based on the outcomes of the identified previously resolved disputes (col. 10, line 54 thru col. 11, line 5); and

presenting the identified likely outcomes to the parties as a potential resolution to the dispute to assist the parties in negotiating a resolution to the dispute(col. 10, line 54 thru col. 11, line 5, col. 11, lines 27-36).

Referring to Claim 109:

Sloo discloses a method further comprising applying a case-based reasoning system to the information to produce a result for use in selection of a mode of resolving the dispute in accordance with an online dispute resolution process (col. 14, lines 32-44).

Referring to Claims 111 and 115:

Sloo discloses a method and system wherein the online dispute resolution system and marketplace have separate databases, the method further comprising:
automatically electronically communicating the transaction data between the database on the online dispute resolution system and the database of the electronic marketplace (col. 6, lines 55-65).

Referring to Claim 65:

Sloo discloses a system wherein the server searches the database to identify previously resolved disputes with facts that are similar to the case information (col. 2, lines 7-20, lines 53-65, col. 4, lines 9-17, col. 10, lines 58-66).

Referring to Claim 66:

Sloo discloses a system wherein the server presents the result of the comparison by presenting the outcomes of identified previously resolved disputes (col. 10, line 58 thru col. 11, line 35).

Referring to Claim 67:

Sloo discloses a system wherein the server summarizes the outcome of identified previously resolved disputes (col. 10, line 58 thru col. 11, line 8, col. 14, lines 45-60).

Referring to Claim 68:

Sloo discloses a system wherein the server presents the result of the comparison by generating an outcome prediction as a function of the facts and outcomes of the identified disputes, and presenting the outcome prediction to the parties (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 69:

Sloo discloses a system wherein the outcome prediction includes at least one likely outcome (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23).

Referring to Claim 70:

Sloo discloses a system wherein the outcome prediction includes associated probabilities of occurrence of the at least one likely outcome (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47-col. 13, line 23).

Referring to Claim 71:

Sloo discloses a system wherein the server presents the at least one likely outcome to the parties as a potential resolution of the dispute (col. 10, line 54 thru col. 11, line 2, col. 11, lines 21-36, col. 12, line 47 thru col. 13, line 23, col. 14, lines 33-34).

Referring to Claim 93:

Sloo discloses a system wherein the server compares the case information to facts of previously resolved disputes to automatically select a resolution mode comprising one of (i) a direct negotiation mode that allows the parties to directly negotiate a resolution to the dispute via the computer network, (ii) a conciliation mode that allows the parties to negotiate the resolution to the dispute through a mediator (judge/jury), and (iii) mediation mode that allows a mediator to propose a resolution to the dispute (Figs. 1-9, col. 13, line 50 thru col. 14, line 16, col. 3, lines 8-67, col. 7, lines 29-40).

Referring to Claim 94:

Sloo discloses a system wherein the server provides a preprogrammed recommended resolution to at least one of the parties based on the comparison (col. 2, lines 53-65, col. 10 line 54 thru col. 11, line 35, col. 14, lines 32-60, col. 17, lines 5-15).

Referring to Claim 95:

Sloo discloses a system wherein the server:
performs an analysis of the dispute and presents pre-programmed recommended resolutions based on the analysis in the first mode (col. 10, line 54 thru col. 11, line 35;
performs a match of needs of the two parties as defined by the dispute to resolve the dispute in a second mode (col. 4, lines 14-17);
providing a medium for the parties to independently resolve the dispute in a third mode (col. 4, lines 19-37, col. 7, lines 29-40); and
assigns a dispute resolution specialist to resolve the dispute in a fourth mode upon failure to reach a recommended resolution (col. 8, lines 5-18).

Referring to Claim 96:

Sloo further discloses a system wherein the server provides a message exchange by which the dispute resolution specialist interacts with the parties to reach a recommended resolution (col. 6, lines 55-68, col. 9, lines 11-13).

Referring to Claim 97:

Sloo further discloses a system wherein the server automatically assigns the dispute resolution specialists (col. 8, lines 5-20).

Referring to Claim 99:

Sloo discloses a system further comprising a software program executing on the server to automatically assemble the case information from records provided by the parties, wherein the software module presents sample resolutions to the parties to aid the parties in resolving the case and presents the case information in a form that identifies areas of agreement between the parties (Fig. 1, col. 10, line 54 thru col. 11, line 5, col. 11, lines 21-36).

Referring to Claim 99:

Sloo discloses a system further comprising:
a first software program operating the server to assemble the case information from records provided by the parties (col. 3, line 26-28); and
a second software program operating on the server to assist a dispute resolution specialist in identifying similar cases from a historical database of past cases (col. 12, lines 25-32).

Referring to Claims 116 and 117:

Sloo discloses a system wherein the dispute resolution system and the marketplace are implemented at least in part as software executing on a computer system having data storage

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devices and wherein the dispute resolution system and the marketplace communicate via the computer system (Fig. 1, col. 3, lines 8-67).

4. Claims 11, 14, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to claims 1 and 112 above, and further in view of Israel et al (US 6,766, 307) (hereinafter referred to as Israel).

Referring to Claim 11:

Sloo does not disclose a method wherein the dispute resolution specialist resolves the dispute by transitioning from a mediation stage to an arbitration stage. However, Israel discloses a method which allows for transition from mediation to arbitration. (col. 2, lines 40-51, col. 11, lines 29-39, col. 23, lines 36-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sloo as taught by Israel to get third party intervention when an agreement cannot be reached.

Referring to Claim 14:

Israel discloses a method further comprising creating a contract between the one or more parties stating the willingness to abide by the recommended resolution (col. 27, lines 12-21- Negotiation Agreement. – parties must agree to the terms and conditions).

Referring to Claim 28:

Israel disclose wherein the dispute resolution is provided as an insurance covering the transaction (col. 6, line 61 thru col. 7, line 5). Furthermore, the fact that the dispute resolution is provided as an insurance covering the transaction is considered to be non-functional descriptive

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language. The language adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. Non-functional descriptive material cannot render non-obvious an invention that would have otherwise been obvious. This descriptive material is not related to the substrate and does not effect how the negotiation process is performed. Thus, this does not distinguish the claimed invention from the prior art, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994),

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the dispute resolution provided as insurance covering the transaction because such data does not functionally relate to the steps in the method claimed and the subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to Claim 29:

Neither Sloo nor Israel discloses a method further comprising requiring a seller associated with the marketplace to be a registered subscriber to the online dispute resolution system Sloo discloses providing access to users(col. 4, lines 1-6) Israel discloses registering with the system (col. 3, lines 5-10, col. 8, line 57 thru col. 9, line 29) Moreover, this data is found to be non-functional descriptive data and therefore does not serve as a limitation on the claims to distinguish over the prior art. The language “registered subscriber” does not exhibit any functional interrelationship with the way in which the computing processes are performed.

Referring to Claim 30:

Sloo does not disclose membership data being communicated or

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automatically showing a visual indicia within the marketplace to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process.

However, Israel discloses membership data being communicated (col. 5, line 64 thru col. 6, line 2) and automatically showing a visual indicia within the marketplace to indicate the availability of the dispute resolution system and the membership of buyers or sellers in the dispute resolution process (col. 8, line 58 thru col. 9, line 15 (hotlinks)).

Referring to Claim 31:

The fact that the visual indicia is a medallion that is a visible symbol of trust to increase the confidence of the buyers or the sellers in executing transaction within the marketplace is found to be non-functional descriptive data which will not distinguish the claimed invention from the prior art in terms of patentability.

5. Claims 110, 113 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to claims 1 and 112 above, and further in view of Collins et al (US 2002/0007362) (hereinafter referred to as Collins).

Referring to Claim 110, 113 and 114:

Sloo discloses the method of claim 1 and the system of claim 112. Sloo does not disclose a method and system further comprising electronically receiving with the online dispute resolution enrollment requests from the marketplace and automatically initiating enrollment of sellers or buyers within the dispute resolution system in response to the electronic requests from the marketplace.

However, Collins discloses a method and system further comprising electronically receiving with the online dispute resolution enrollment requests from the marketplace and automatically initiating enrollment of sellers or buyers within the dispute resolution system in response to the electronic requests from the marketplace (page 4 [0046]- registration stage which includes identification of relevant parties). Status data would inherently have to be maintained since Collins determines if the parties are eligible.

Furthermore, the fact that the user is a registered subscriber is found to be nonfunctional descriptive data. This does not alter how the method or system works and thus will not distinguish the claimed invention from the prior art in terms of patentability.

6. Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo in view of Slaikeu (US Patent 2001/0007106).

Sloo discloses intervention by pre-qualified persons (judge/jury)(col. 8, lines 5-18)

Sloo does not a method further comprising:
training a dispute resolution specialist by requiring the dispute resolution specialist to experience transactions within online marketplaces including at least an auction site;
outputting simulated online dispute resolution cases to the dispute resolution specialists via the computer network to assess the skill of the dispute resolution specialists; and
assigning online disputes to the dispute resolution specialists only upon completion of the training and successful resolution of the simulated online dispute resolution cases.

However, Slaikeu discloses a method comprising training a dispute resolution specialist (page 3 [0025- 0026]).

Furthermore, the Examiner takes Official Notice that online training is old and well known and has become an established business practice as is exemplified by online CLE classes online graduate classes and testing. Furthermore, providing simulations of situations is also an old and well known way to train.

Response to Arguments

Applicant's arguments filed April 12, 2004 have been fully considered but they are not persuasive.

The Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Elangovan, AR: Managerial third party dispute intervention: A prescriptive model of strategy selection, Academy of Management Review discloses a set of rule which are applied to determine the appropriate intervention strategy. A decision tree is developed to prescribe the appropriate intervention strategy in different dispute situations.

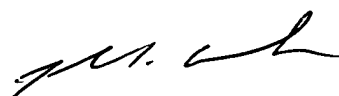
Nyhart, JD discloses computer based simulation models to determine outcomes and a decision tree analysis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM



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